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In re Application of ARIMA et al. :
Application No.: 09/403,603 :
PCT No.: PCT/JP98/01844 :
Int. Filing Date: 22 April 1998 : DECISION
Priority Date: 23 April 1997 :
Attorney Docket No.: 19051.072 :
For: ELECTRODE AND BATTERY :

This is a decision on applicants' "Renewed Petition Under 37 CFR 1.182", which is also considered a petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 09 February 2001.

BACKGROUND

On 03 December 1999, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the declaration must be filed in compliance with 37 CFR 1.497(a) and (b) along with a surcharge for filing the declaration after the thirty month period.

On 31 May 2000, applicants submitted a declaration executing PCT/JP98/01844 with a petition for extension of time for a five month period. A copy of the declaration was again submitted by facsimile on 15 June 2000.

On 29 June 2000, Notification of Defective Response (Form PCT/DO/EO/916) and Notification of Defective Oath or Declaration (Form PCT/DO/EO/917) were mailed to applicants indicating that the declaration submitted was not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68 and did not identify the inventors. Specifically, Form PCT/DO/EO/916 indicated that "the declaration has two sole or first inventors, Yoichiro Arima and Hisashi Tsukamoto. The names of the fifth and seventh inventors on the declaration does not correspond with the published IA [international application]".

On 18 September 2000, in response to the Notification of Defective Response and Notification of Defective Oath or Declaration, applicants refiled the originally filed declaration, with hand-written revisions to the inventor order and changes in two inventors' last names in ink and highlighted. A change of address was also filed. The filing was considered a petition under 37 CFR 1.182.

On 12 December 2000, a decision on applicant's submission was mailed to applicant

On 12 December 2000, a decision on applicant's submission was mailed to applicant indicating that the declaration as filed was unacceptable because the declaration named two individuals as the first or sole inventor, two individuals as second inventor, two individuals as third inventor and the declaration did not list all the inventors named on the publication. The declaration filed on 31 May 2000 also indicated a correction to the spelling of the fifth and seventh listed inventor's names. No explanation was provided for either change.

On 09 February 2001, applicants filed the instant "Renewed Petition Under 37 CFR 1.182" with a new declaration executed by eight of the nine inventors and an explanation of the refusal of inventor Hisashi Tsukamoto to sign the declaration.

DISCUSSION

A review of the application filed reveals that the Notification of Defective Response and Notification of Defective Oath or Declaration were mailed to applicants on 29 June 2000. A ONE MONTH time limit to respond to said notifications was set.

In his 18 September 1999 submission, applicant alleges that he mailed an executed declaration on 17 July 2000. However, the 17 July 2000 submission is not found in the application file. The 18 September 1999 submission includes a copy of the allegedly earlier filed declaration and a copy of the date-stamped postcard receipt of 19 April 2000 but does not include "a copy of the date-stamped postcard receipt" for 17 July 2000.

Without the 17 July 2000 submission, the application must be considered abandoned for failure to timely respond to the Notification of Defective Response. In requesting withdrawal of the abandonment of the application, applicant must file a petition under 37 CFR 1.181 providing a true copy of the **USPTO date-stamped** postcard receipt and the declaration filed on 17 July 2000.

Acceptance of the Declaration under 37 CFR 1.47

It is noted that the declaration submitted on 09 February 2001 was executed by all inventors except Hisashi TSUKAMOTO. An explanation regarding the correction of the names of four inventors to: Hisashi SHIOTA, Hiroaki URUSHIBATA, Shoji YOSHIOKA and Jun ARAGANE was provided in a letter by Japanese patent attorney, Masaki Kawasaki dated 31 January 2001. In brief, Mr Kawasaki's explanation is considered a transliteration error which occurred in the preparation of the international application. Mr. Kawasaki indicates that the correct names for the inventors are as follows: Hisashi SHIOTA, Hiroaki URUSHIBATA, Shoji YOSHIOKA and Jun ARAGANE. These inventors have executed the declaration accordingly.

Applicants request that the declaration be accepted without the signature of inventor Hisashi TSUKAMOTO. To accept an application without the signature of an inventor, a petition under 37 CFR §1.47(a) must be filed. The petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Items (1), (3), and (4) have been submitted and satisfy the requirements of 37 CFR 1.47(a).

Applicants are advised that Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor....

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

[Emphasis added]

Here, Petitioner submitted the declaration of facts under 37 CFR § 1.47(a)(2) signed by Japanese patent attorney Masaki Kawasaki along with three letters dated 31 January 2001, 02 February 2001 and 06 February 2001. The letters are virtually identical in content with regard to the statement of facts in support of the petition under 37 CFR §1.47(a). The letters do not meet the requirements of 37 CFR §1.47(a). The letters are not statements of first hand knowledge as to Mr. Tsukamoto's refusal to join in the application and surmises the reasons that inventor "Tskamoto" has not signed.

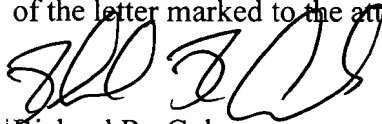
This is insufficient evidence to conclude that applicant/inventor Hisashi Tsukamoto has refused to sign the *application*. What is required is that Mr. Tsukamoto be presented with a copy of all of the national stage application papers (oath and declaration, specification, including claims and drawings) for this application as identified above. Petitioner has not demonstrated that: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 09/403,603 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature, sent to his last known address and (2) Mr. Tsukamoto's refusal to sign, either in writing or by telephone, these documents.

CONCLUSION

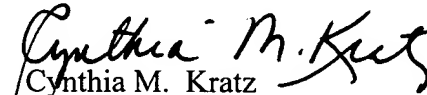
For the reasons above, the application is considered **ABANDONED**.

The petition under 37 CFR §1.47(a) is **DISMISSED** without prejudice.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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